

## Remarks

### Rejections under 35 U.S.C. 103

Claims 1 and 5-12 were rejected as being unpatentable over Westall et al. (WO 03/016380 in view of Morita et al. (US 6,641,805).

Applicant respectfully submits that the present claims are non-obvious over Westall in view of Morita.

Applicant respectfully submits the 103 rejection does not provide a sufficient factual inquiry of obviousness as stated in *Graham v. John Deere Co.*, and further described in the Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in view of the Supreme Court Decision in *KSR v. Teleflex Inc.*, (Federal Register/Vol. 72, No. 195, pages 57526-57535). Applicant respectfully submits the above rejection fails to establish a *prima facie* case of obviousness against the present claims. Applicant submits there is not sufficient teaching, suggestion, or motivation to combine the teachings of Westall and Morita as asserted in the 07/09/2008 office action to establish *prima facie* obviousness.

Westall indeed teaches amino functional polysiloxanes for textile treatments. Westall further teaches its amino functional polysiloxanes can be further reacted, as found in paragraph [0027]. However, Westall fails to teach or suggest reaction of its amino functional polysiloxanes with fluoro-substituted alkyl esters of an ethylenically unsaturated carboxylic acid, as presently claimed.

The 07/09/2008 obviousness rejection relies on the teaching of Morita for its fluorine-containing (meth)acrylates, asserting that it would have been obvious at the time of invention to add the fluorine-containing (meth)acrylates of Morita in the composition Westall. The rejection asserts the motivation to do so would have been Morita's suggestions to improve the waterproofing property and the water and oil repellency to films.

Applicant respectfully traverses this assertion and believes there is no suggestion to combine the teachings of Westall and Morita. Applicant believes that one skilled in the art, seeking solutions to the problem of finding textile treatment agents which impart oleophobicity and oil repellency to fabrics without imparting a harsh feel to the fabric

surface, while at the same time imparting an improvement in feel compared to untreated fabric, would not look to Morita for such solutions for at least two reasons. First, Morita emphasizes free radical chemistry with certain silicon-containing polymerizable compounds, and second, Morita is primarily concerned with finding new compatibilizers for cosmetic formulations.

Morita teaches reaction of its fluorine-containing (meth) acrylates with a silicon-containing polymerizable compound via a radical polymerization, as discussed in column 4, lines 63-68 (reproduced below).

In the present invention, the silicon-containing polymerizable compound which undergoes radical polymerization  
65 with the fluorine-containing (meth)acrylate is the mercapto-modified silicone, the azo group-containing silicone or the polymerizable silane.

There is no teaching or suggestion to use amino functional polysiloxanes, as presently claimed. Rather, Morita is specific to mercapto-modified silicone, azo group containing silicone, or polymerizable silane.

Morita is primarily concerned the solving the technical problem of finding new compatibilizers for the improvement in affinities between fluorine-containing raw materials and fluorine-free raw materials, as summarized in column 1 lines, 50-60.

On the other hand, fluorine-containing raw materials such  
as a fluorine compound-treated powder and perfluoropoly-  
ether have recently come to be blended in cosmetic prepa-  
rations. Since these fluorine-containing raw materials have  
poor affinities with fluorine-free raw materials such as those  
of hydrocarbon type and of silicone type which have been  
used widely, it is very difficult to blend them in preparations  
with stability. Therefore, the development of compatibilizers  
for the improvement in affinities between fluorine-  
containing raw materials and fluorine-free raw materials has  
been demanded.

Conversely, starting with Westall, there is no specific teaching or suggestion to add fluoro-substituted alkyl esters of an ethylenically unsaturated carboxylic acid, as presently claimed.

Claims 2-4 were rejected as being unpatentable over Westall et al. (WO 03/016380 in view of Morita et al. (US 6,641,805), as applied to claim 1 above, in further view of Blizzard et al. (US 5,739,192).

Applicant believes claim 1 is non-obvious over the combination of Westall and Morita for the reasons stated above. Therefore, Applicant respectfully submits the rejection of claims 2-4 is mooted. Applicant relies on the remarks made above to overcome the obviousness rejection.

The present response is being submitted within the statutory period for response to the outstanding Office Action. Applicant authorizes the USPTO to charge deposit account 04-1520 for a one month extension, and any other fees that should be necessary to maintain the pendency of the application.

In view of the above, it is respectfully submitted that the claims are in condition for allowance. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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